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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/222,443	12/29/1998	HONGJUN YANG	17100	3159

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EXAMINER

CEPERLEY, MARY

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/222,443

Applicant(s)

YANG ET AL.

Examiner

Mary (Molly) E. Ceperley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1) Although specific claims are cited in the rejections below, these rejections are also applicable to all other claims in which the noted problems/language occur.

2) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3) Claims 29-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is maintained for the reasons set forth in paragraph **3)** of the October 20, 2004 Office action. See MPEP sections 2163.04 II. and 2163.05.

Applicants' arguments filed April 17, 2004 have been fully considered but they are not persuasive.

Applicants cite page 7, lines 4-29 of the specification as providing descriptive support for the method of claim 24 (Remarks, page 10). However, this section of the specification describes the detection of "a chemical moiety" by a method which recites the generic steps of forming a reagent mixture containing the chemical moiety and subsequently inducing and detecting the emission of electromagnetic radiation. This generic description clearly does not support the method of claim 24 which requires a specific set of reactants and reaction steps. For example, there is no indication in this section of the specification that "inducing the moiety to emit electromagnetic radiation" uses the "agent" described in step (a)(i) of claim 24 and involves the differential oxidation described in step (b) of claim 24 ("oxidizing said agent but not said chemical moiety"). Similarly, Example 2 which merely states that "cyclic voltammograms were established" for a europium chelate with "TPA" (an undefined "agent"?) does not support the specific set of steps recited in claim 24 (Remarks, pages 10 and 11). Further,

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Example 2 is inconsistent with claim 24 in that Example 2 indicates that electrochemiluminescence of Eu *"is directly caused by the oxidation of TPA"* while claim 24 indicates that the step of "inducing the chemical moiety to emit electrochemiluminescence" of step (c) is a separate step which is required after and in addition to the oxidation of step (b), i.e. the oxidation step does not, by itself, elicit electrochemiluminescence of the "chemical moiety".

With regard to paragraphs **3)b)** and **3)d)** of the last Office action (Remarks, paragraph bridging pages 11 and 12), there is no indication in the specification at page 4 that the "electrochemiluminescent labels" and the term "chemical moiety" of claim 24 are one and the same entity. Thus, there is no definitive description in the specification of the term "chemical moiety" nor is there a definitive description of the term "agent". The relevance of the citation of page 24, lines 9-22 of the specification is not understood (Remarks, page 12). This section of the specification states that "the **chemical moiety** may be oxidized by exposure to an energy source" while the reagent of step (a)(ii) of claim 24 is defined as "a **chemical moiety** which is not oxidized".

4) Claims 24-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons stated in paragraph **4)** of the last Office action with the following exceptions: (i) newly presented claims 40-43 adequately define the term "chemical moiety"; (ii) the amended term "higher oxidation state" is acceptable.

Contrary to applicants' statement at page 14 of the Remarks, the terms at issue cannot be "properly construed in view of the specification and what is known in the prior art". The specification fails to both provide adequate definitions of these terms and to define an exact "prior art" context for determining the meaning and scope of the terms in question. Without an adequate description of the nature, structure and scope of these terms, the claims remain indefinite as to exactly what is meant to be included.

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5) THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6) An inquiry of a general nature which is **not related to the prosecution on the merits** should be directed to Technology Center 1600 telephone number (571) 272-1600. The general fax number for the USPTO is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary (Molly) E. Ceperley whose telephone number is (571) 272-0813. The examiner can normally be reached from 8 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le, can be reached on (571) 272-0823.

July 09, 2004


Mary (Molly) E. Ceperley
Primary Examiner
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